

Appl. No. 10/032,962
Amtd. dated July 10, 2006
Reply to Office Action of April 11, 2006

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REMARKS

Applicant has carefully reviewed the Office Action mailed April 11, 2006, prior to preparing this response. Currently claims 1-5, 7-18 and 23-28 are pending in the application, wherein claims 1-5, 8, 11-14 and 16 have been rejected and claims 7, 9, 10, 15, 17, 18 and 23-28 have been withdrawn from consideration. Claims 1, 5, 11 and 12 have been amended, claims 23-28 have been cancelled, and claims 29-37 have been added with this amendment. No new matter has been added with these amendments. Favorable consideration of the following remarks is respectfully requested.

Applicant respectfully asserts newly presented claim 31 is directed to a balloon for a balloon dilatation catheter and claims 32-37 are directed to a combination including the subcombination claimed in claim 31. As such, Applicant respectfully asserts restriction of claims 32-37 would be improper. Section 806.05(c) of the Manual of Patent Examining Procedure, which governs criteria of distinctness between combination and subcombination claims, allows both combination and subcombination claims in a single application, in instances where both two-way distinctness and reasons for insisting on restriction are supported. The M.P.E.P. states that distinctness can be shown "if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination." Applicant respectfully asserts claims 32-37, as currently presented, require the particulars of the subcombination currently claimed in claim 31, thus don't meet the requirements necessary for restriction. Therefore, claims 32-37, which don't meet the two-way distinctiveness test, are believed not subject to restriction under 35 CFR §1.145. Substantive examination of these claims is respectfully requested.

Claims 11-14 and 16 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 11 has been amended, thus obviating the rejection.

Claims 1-5, 8, 11-14 and 16 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Shoup et al., U.S. Patent No. 5,591,129. Applicant respectfully traverses this rejection.

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Regarding claim 1, in the Office Action, the Examiner identifies the balloon taught in Shoup at Figure 12 as having a first end (the right end) proximate reference numeral 29 and a second end (the left end) proximate reference numeral 19. The Examiner further states that "the plurality of voids are configured such that the void volume proximate the second end is greater than the void volume proximate the first end of the balloon waist." Office Action, May 11, 2006, page 4. Thus, the Examiner has made an admission that the void volume proximate the left end toward reference numeral 19 (closest to the expandable portion of the balloon) is greater than the void volume proximate the right end toward reference numeral 29 (furthest from the expandable portion of the balloon). Indeed, the Examiner makes a further admission that "Figure 12 shows the left most orifice as being closer to the left end (wherein the left end is just to the left of the distal end of the lead line for reference numeral 19) as compared to the distance between the rightmost orifice and the right end (wherein the right end is at the arrow for reference numeral 29)." Office Action, May 11, 2006, pages 5-6. Applicant respectfully asserts that this arrangement, shown in Figure 12 of Shoup, is not what is claimed in claim 1, which recites that "the void volume proximate the second end is greater than the void volume proximate the first end," wherein the first end is adjacent the expandable region of the balloon.

Furthermore, the Applicant asserts it would not have been obvious to one skilled in the art at the time of the invention, without guidance from the inventive contributions attributed to the current disclosure, to do what is currently claimed as there at least is no motivation or suggestion in the prior art to do so. The Manual of Patent Examining Procedure, which cautions Examiners not to fall victim to the insidious effect of a hindsight syndrome, states that it is "necessary that the decisionmaker forget what he or she has been taught...about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." M.P.E.P. §2141.01 III, quoting *WL Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Applicant asserts claim 1, and thus claims 2-5 and 8 which depend from claim 1, are currently in condition for allowance. Withdrawal of the rejection is respectfully requested.

Regarding claim 11, the Examiner states "the void volume of Shoup et al. increases distally along the length of the balloon waist toward the distal end since the void volume is relatively small at the left side of a set of openings and then increases toward the distal end of the

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waist until it reaches a maximum at the center of the set of openings." The Examiner's basis of rejection does not meet the limitation of claim 11 which recites "the void volume per unit length increases distally along a substantial portion of the length of the balloon waist toward the distal end." Applicant asserts the distance across one-half of an orifice 26, 27 is not a substantial length of the "waist" which the Examiner asserts extends from element 19 to element 29.

Applicant asserts claim 11, and thus claims 12-14 and 16 which depend from claim 11, are currently in condition for allowance. Withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,



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